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08/873,974	06/12/1997	MICHAEL C. SCROGGIE	CAT/34-SCRO-US	2461
31518	7590	03/13/2006	EXAMINER	
NEIFELD IP LAW, PC 4813-B EISENHOWER AVENUE ALEXANDRIA, VA 22304			ROBINSON BOYCE, AKIBA K	
			ART UNIT	PAPER NUMBER
			3639	
DATE MAILED: 03/13/2006				

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 08/873,974  
Filing Date: June 12, 1997  
Appellant(s): SCROGGIE ET AL.

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Richard Neifeld  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12/12/05 appealing from the Office action mailed 7/12/05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

-An appeal is pending in related case for application number 09/505632, which has not yet been docketed to the BPAI, but was subject of a prior appeal to the BPAI having BPAI docket 2002-0329.

-A prior decision in this appeal BPAI docket number 2004-1267 was mailed in this application on July 29, 2004.

-A prior decision in this appeal BPAI docket number 2004-1267 on request for rehearing was mailed September 30, 2004.

-An order in the appeal to the CAFC docket number 05-1164 remanding the case to the USPTO was issued March 9, 2005.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 54, 63-69, 73-79 and 83-89.

Claims 50-53, 60-62, 70-72 and 80-82 are claims not included in the appeal.

Due to the BPAI decision filed 7/29/04, the rejections of claims 50-53, 60-62, 70-72 and

80-82 were sustained by the BPAI, and therefore are not required to be included in this rejection or this appeal.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

Appellant's brief presents arguments relating to whether the BPAI should render judgement that rejections of any other one of claims 50-89 based upon Sloane and Narashimhan should be reversed. As stated in section (3) above, due to the BPAI decision filed 7/29/04, the rejections of claims 50-53, 60-62, 70-72 and 80-82 were sustained by the BPAI, and therefore are not required to be included in this rejection or this appeal. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

**(7) Claims Appendix**

Claims Appendix contain(s) substantial errors. Accordingly, claims 50-53, 55-62, 70-72, and 80-82 should not be included in the Appendix to the Examiner's Answer.

**(8) Evidence Relied Upon**

Copy of BPAI decision in the sister case, the 3 prior decision in this case, and the order from the CAFC remaining this case to the USPTO are attached as appendices.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 63, 73 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211).

As per claims 63, 73 and 83, Sloane fails to disclose:

Wherein said cooperative network site transmits said geographically limited list of retailers based on a postal code...

Official notice is taken that it is old and well known in the art to have a geographical list sorted by postal code.

It would have been obvious to one of ordinary skill in the art to sort a geographical list by postal code in order to specifically define the closest locations in which incentive data can be sent.

Claims 54, 64-69, 74-79, and 84-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Narasimhan, et al (US Patent 6,237,145 B1).

As per claim 54, 64, 74 and 84 Sloane discloses:

Transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site...(Col. 7, lines 4-13, where the incentive selection data is represented by the consumer promotion or message offered with the item on sale);

Transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site...(Col. 8, lines 3-7, where the incentives are represented by discount or promotion).

Sloane fails to disclose, however Narasimhan et al discloses:

Transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site...(Col. 8, lines 4-19, where the query is represented by the extended search for a specific type of promotion which is also defined as an extended search query in Col. 8, lines 41-47).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to transmit incentive data in response to a query from a consumer with the motivation of giving the consumer more of a reason to participate in the incentive program since he/she would be more likely to receive an incentive for a product in which he/she is interested.

As per claims 55, 65, 75, 85, Sloane discloses:

Said consumer transmits incentive selection data.../transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site.../means for transmitting by said consumer incentive selection data...(Col. 7, lines 4-13, where the incentive selection data is represented by the consumer promotion or message offered with the item on sale);

Said cooperative network site transmits incentives corresponding to said selection data.../transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.../means for transmitting from said cooperative network site incentives corresponding to said selection data...(Col. 8, lines 3-7, where the incentives are represented by the discount or promotion).

Sloane fails to teach the following, however Narasimhan et al discloses:

Wherein, in response to a query from said consumer made over said communication network from said retailer network site, said cooperative network site transmits a consumer personal page.../transmitting from said cooperative network site a consumer personal page including incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to a query from said consumer made over said communication network from said retailer network site.../means for transmitting from said cooperative network site a consumer personal page including incentive data...(Col. 4, lines 41-45, where the

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personal page is represented by the presentation of the promotions in a manner customized to a particular user's interests via the internet by way of a navigator). It would have been obvious to one of ordinary skill in the art to transmit a consumer personal page with the motivation of offering the consumer with a page specifically customized for his or her purchasing purposes.

As per claim 56, 66, 76 and 86, Sloane discloses:

Said consumer transmits incentive selection data.../transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site.../means for transmitting by said consumer incentive selection data selected from said incentive data to said cooperative network site via said retailer network site...(Col. 7, lines 4-13, where the incentive selection data is represented by the consumer promotion or message offered with the item on sale);

Said cooperative network site transmits incentives corresponding to said selection data.../transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site.../means for transmitting from said cooperative network site incentives corresponding to said selection data to said consumer via said retailer network site...(Col. 8, lines 3-7, where the incentives are represented by the discount or promotion).

Sloane fails to teach the following, however Narasimhan et al discloses:



Wherein, in response to said consumer transmitting an identification code over said communication network from said retailer network site, said cooperative network site transmits incentive data for manufacturer offers available.../transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to said consumer transmitting an identification code over said communication network from said retailer network site, and basing said incentive data on consumer specific data of said consumer associated with said identification code.../means for transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site, in response to said consumer transmitting an identification code over said communication network from said retailer network site, and basing said incentive data on consumer specific data of said consumer associated with said identification code...(Col. 6, lines 50-59, Col. 4, lines 41-45, Col. 9, lines 5-12).

It would have been obvious to one of ordinary skill in the art to transmit an identification code over the communication network with the motivation of transmitting the incentive to a specific identified consumer.

As per claim 57, 67, 77 and 87, Sloane discloses:

Wherein said incentive data is based on said consumer specific data comprising a shopping history of said consumer...(Col. 8, lines 50-63).

As per claim 58, 68, 78 and 88, Sloane fails to disclose, however Narasimhan et al discloses:

Wherein said incentive data is based on said consumer specific data comprising demographic data...(Col. 9, lines 5-16).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to base incentive data on demographic data with the motivation of offering incentives to customers based on the size, density and distribution of a population of consumers.

As per claim 59, 69, 79 and 89, Sloane fails to disclose, however Narasimhan et al discloses:

Wherein said incentive data is based on said consumer specific data comprising customer profile data...(Col. 1, lines 15-20).

It would have been obvious to one of ordinary skill in the art for incentive data to be based on customer profile data with the motivation of offering customers incentives with relation to specific customer qualities:

#### **(10) Response to Argument**

First, appellant argues that they are entitled to a judgement reversing the 112 rejections. The following is the reason for the reverse of the 112 rejections: The examiner withdrew the rejections as a result of arguments presented in the appeal brief submitted 12/23/02.

The appellant also argues whether the BPAI should render judgement that rejections of any other one of claims 50-89 based upon Sloane and Narasimahan. Specifically, appellant argues claim 50, 60, 70 and 80 based upon Sloane and Narasimahan should be reversed. However, as stated in section (3) above, due to the

BPAI decision filed 7/29/04, the rejections of claims 50-53, 60-62, 70-72 and 80-82 were sustained by the BPAI, and therefore are not required to be included in this appeal.

The appellant also argues the rejections of 63, 73 and 83 based upon Sloane. Specifically, appellant argues that the examiner fails to show in the prior art the three entity process in which the cooperative network site acts in response to a client communication sent to the retailer or manufacturer web site as defined by independent claim 60. However, arguments related to claim 60 are moot in this appeal. Claim 63 recites "transmitting from said cooperative network site said geographically limited list of retailers based on a postal code provided by said consumer to said cooperative network site via said manufacturer network site". Sloane discloses transmission from a cooperative network site in Col. 7, lines 15-22 by the on-line computer network (LAN OR WAN). This computer network acts as the cooperative network site since this addition allows the manufacturer computer system to communicate with the retailer computer system through the transmission of promotional retailer data, which can be based on purchasing behavior as discussed in col. 4, lines 29-31 of Sloane. However, as disclosed in the rejection, the transmittal of a geographically limited list of retailers based on postal code is old and well known in the art for the motivation of specifically defining the closest locations in which incentive data can be sent. By basing the geographically limited list of retailers on postal codes, one can provide promotional and discount information based on the consumers purchasing behavior, since purchasing behavior includes purchasing products in certain geographical areas. The same

arguments applied for claims 73 and 83, therefore these claims remain rejected for the same reasons discussed with respect to claim 63.

Appellant argues the rejections of claims 54-59, 64-69, 74-79 and 84-89 under 103 based upon Sloane and Narasimhan should be reversed. For purposes of appeal, only the rejection of claims 54, 64-69, 74-79, and 84-89 will be discussed since the rejections of claims 50-53, 60-62, 70-72 and 80-82 were sustained by the BPAI, and therefore are not required to be included in this appeal. This discussion excludes claims 55-59. Specifically, as per claims 54, 64, 74 and 84, appellant argues that Sloane fails to disclose a middle man between Sloane's computer/controller to correspond to the claimed "cooperative network site". However, Sloane discloses the cooperative network site is disclosed by Sloane as described above in the preceding paragraphs. In the preceding paragraphs, it is shown that Sloane discloses transmission from a cooperative network site in Col. 7, lines 15-22 by the on-line computer network (LAN OR WAN). This computer network acts as the cooperative network site since this addition allows the manufacturer computer system to communicate with the retailer computer system through the transmission of promotional retailer data, which can be based on purchasing behavior as discussed in col. 4, lines 29-31 of Sloane. In addition, appellant argues that Narasimhan et al fails to disclose "transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site in response to a query from said consumer made over said communication network from said retailer network site". However, it is the *combination* of Sloane and Narasimhan et al that

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discloses this limitation. Specifically, Narasimhan et al discloses an extended search for a specific type of promotion in Col. 8, lines 4-19. In this case, the query is represented by this extended search, which is also defined as an extended search query in Col. 8, lines 41-47, which results in the transmission of promotion suggestions to the consumer. With Sloan's cooperative network site in combination with Narasimhan et al's query, the limitation of "transmitting from said cooperative network site incentive data for manufacturer offers available at said retailer to said consumer via said retailer network site in response to a query from said consumer made over said communication network from said retailer network site" is disclosed.

Finally, appellant argues that the examiner provided no statement providing a motivation to combine. However, in the previous office action, examiner has stated "It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to transmit incentive data in response to a query from a consumer with the motivation of giving the consumer more of a reason to participate in the incentive program since he/she would be more likely to receive an incentive for a product in which he/she is interested". Since the consumer in Narasimhan et al presents a query for the purpose of acquiring products/service of interest as described in col. 8, lines 41-47, it would be reasonable to disclose presenting a query, and in response, transmitting incentive data relating to that query in order to keep the consumer interested.

#### **(11) Related Proceeding(s) Appendix**

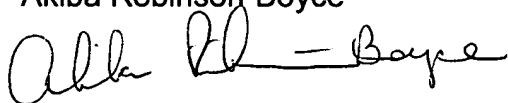
Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Akiba Robinson-Boyce

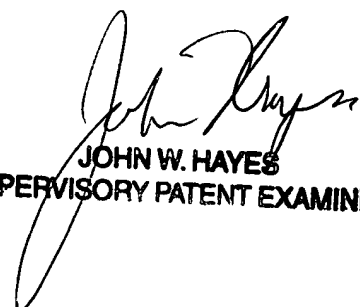
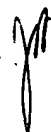


Conferees:

John Weiss



John Hayes



**JOHN W. HAYES**  
**SUPERVISORY PATENT EXAMINER**